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10/763,814	01/22/2004	Anthony F. Gigliotti	035813-003	5015

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EXAMINER

VO, TED T

ART UNIT	PAPER NUMBER
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2191

MAIL DATE	DELIVERY MODE
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10/01/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/763,814	Applicant(s) GIGLIOTTI ET AL.	
	Examiner TED T. VO	Art Unit 2191	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 20-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 20-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/7/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the amendment filed on 07/07/2008.

Claims 1-15, 20-36 are pending in the application.

Response to Arguments

2. This is in response to the argument remarks filed on 07/07/2008. Applicants traverse the rejection. Applicants argued Microsoft does not do patching via Peer-To-Peer (Remarks: “Microsoft Does Not Disclose Receiving Application And System Information From One Or More Inoculation Clients Installed On The Devices, The Receiving Performed Via Peer-To-Peer Communication”). It appears Applicants argued Microsoft does not have a Global Update Repository for patching (Remarks: Microsoft Does Not Disclose Comparing Application And System Information With Application And Version Information In A Global Update Repository To Determine If An Update Exists For A Corresponding Application Controlled By An Inoculation Client, The Global Update Repository Including Updates From Multiple Application Manufacturers). Applicants also argued to all dependent claims.

Examiner responds: Under 37 CFR 1.111(b) (c), its requirement for an argument is to point out the patentability of a claim. It should be noted that a distribution of a piece of software or of patches in a network is not new in the art. It is done commonly in the software companies whose clients are frequently attacked by hackers. As seen in the Microsoft reference, it discussed the principle of this present specification, where the arguments do not point out any

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patentable differences. Using peer-to-peer or global update repository does not present a patentable feature for a network, but only a strategy. The use of a peer-to-peer or a repository for updating the patch does not produce a new or an unexpected result. Its common purpose is to provide patching to an inoculation client from a patched distributor whether it is via peer-to-peer, central server, or another computer repository. The recited feature such as, *receiving application*, either from a server or a peer-to-peer communication does not make a patentable difference. The recited feature such as, *comparing the application and system information with application and version information*, is seen in Microsoft Baseline Security Analyzer. The recited feature such as, *queueing the update*, and *automatically transmitting the update*, is only a response and done by almost every update mechanism.

Therefore, claiming features, which are merely changing components or language terminologies and do not produce any new or unexpected result, would render prima facie obviousness.

See MPEP:

CHANGES IN SIZE, SHAPE, OR SEQUENCE OF ADDING INGREDIENTS

A. Changes in Size/Proportion

In re Rose , 220 F.2d 459, 105 USPQ 237 (CCPA 1955) (Claims directed to a lumber package “of appreciable size and weight requiring handling by a lift truck” where held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art.); In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) (“mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled.” 531 F.2d at 1053, 189 USPQ at 148.).

In Gardner v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984),

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cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

B. Changes in Shape

In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (The court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.).

C. Changes in Sequence of Adding Ingredients

Ex parte Rubin, 128 USPQ 440 (Bd. App. 1959) (Prior art reference disclosing a process of making a laminated sheet wherein a base sheet is first coated with a metallic film and thereafter impregnated with a thermosetting material was held to render prima facie obvious claims directed to a process of making a laminated sheet by reversing the order of the prior art process steps.). See also In re Burhans, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results); In re Gibson, 39 F.2d 975, 5 USPQ 230 (CCPA 1930) (Selection of any order of mixing ingredients is prima facie obvious.).

V. MAKING PORTABLE, INTEGRAL, SEPARABLE, ADJUSTABLE, OR CONTINUOUS

A. Making Portable

In re Lindberg, 194 F.2d 732, 93 USPQ 23 (CCPA 1952) (Fact that a claimed device is portable or movable is not sufficient by itself to patentably distinguish over an otherwise old device unless there are new or unexpected results.).

B. Making Integral

In re Larson, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (A claim to a fluid transporting vehicle was rejected as obvious over a prior art reference which differed from the prior art in claiming a brake drum integral with a clamping means, whereas the brake disc and clamp of the prior art comprise several parts rigidly secured together as a single unit. The court affirmed the rejection holding, among other reasons,

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“that the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice.”); but see *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983) (Claims were directed to a vibratory testing machine (a hard-bearing wheel balancer) comprising a holding structure, a base structure, and a supporting means which form “a single integral and gaplessly continuous piece.” Nortron argued that the invention is just making integral what had been made in four bolted pieces. The court found this argument unpersuasive and held that the claims were patentable because the prior art perceived a need for mechanisms to dampen resonance, whereas the inventor eliminated the need for dampening via the one-piece gapless support structure, showing insight that was contrary to the understandings and expectations of the art.).

C. Making Separable

In re *Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) (The claimed structure, a lipstick holder with a removable cap, was fully met by the prior art except that in the prior art the cap is “press fitted” and therefore not manually removable. The court held that “if it were considered desirable for any reason to obtain access to the end of [the prior art’s] holder to which the cap is applied, it would be obvious to make the cap removable for that purpose.”).

D. Making Adjustable

In re *Stevens*, 212 F.2d 197, 101 USPQ 284 (CCPA 1954) (Claims were directed to a handle for a fishing rod wherein the handle has a longitudinally adjustable finger hook, and the hand grip of the handle connects with the body portion by means of a universal joint. The court held that adjustability, where needed, is not a patentable advance, and because there was an art-recognized need for adjustment in a fishing rod, the substitution of a universal joint for the single pivot of the prior art would have been obvious.).

E. Making Continuous

In re *Dilnot*, 319 F.2d 188, 138 USPQ 248 (CCPA 1963) (Claim directed to a method of producing a cementitious structure wherein a stable air foam is introduced into a slurry of cementitious material differed from the prior art only in requiring the addition of the foam to be continuous. The court held the claimed continuous operation would have been obvious in light of the batch process of the prior art.).

All of above appear that an added element or added component in a claim will not render obviousness if it is only if it causes a new or unexpected result. The added of peer-to-peer network

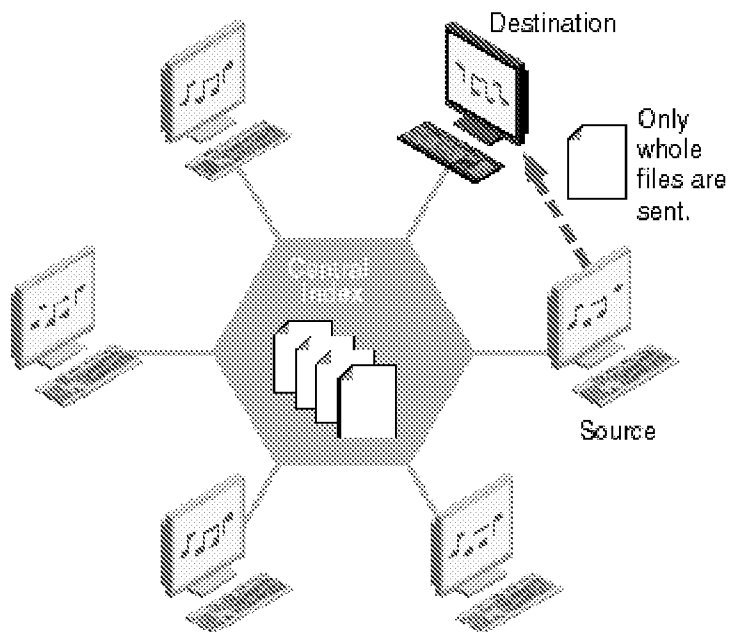
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or Global Update Repository is not new in term of transmitting data, but it is well-known in the art. For example:

From Computer Desktop Encyclopedia
© 2004 The Computer Language Co. Inc.

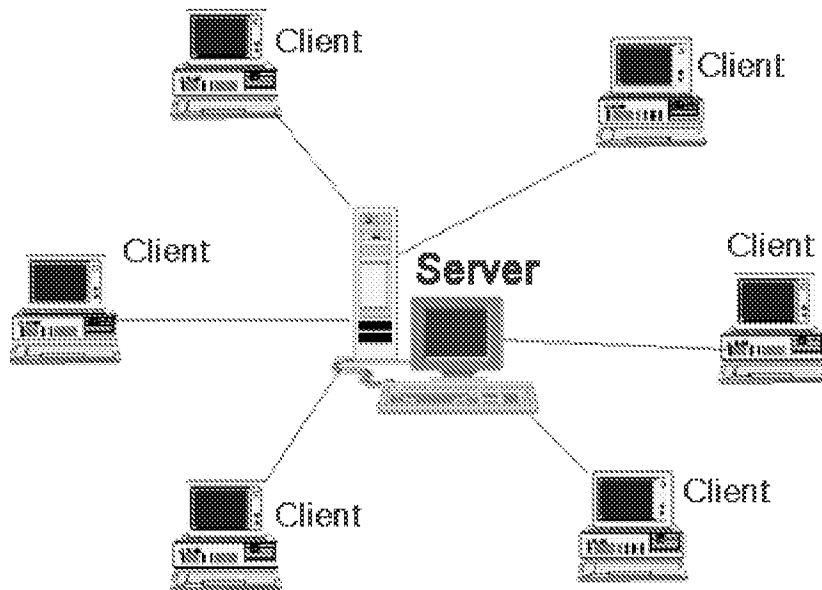
THE ORIGINAL NAPSTER

Napster provided a central directory of users who had files to share.

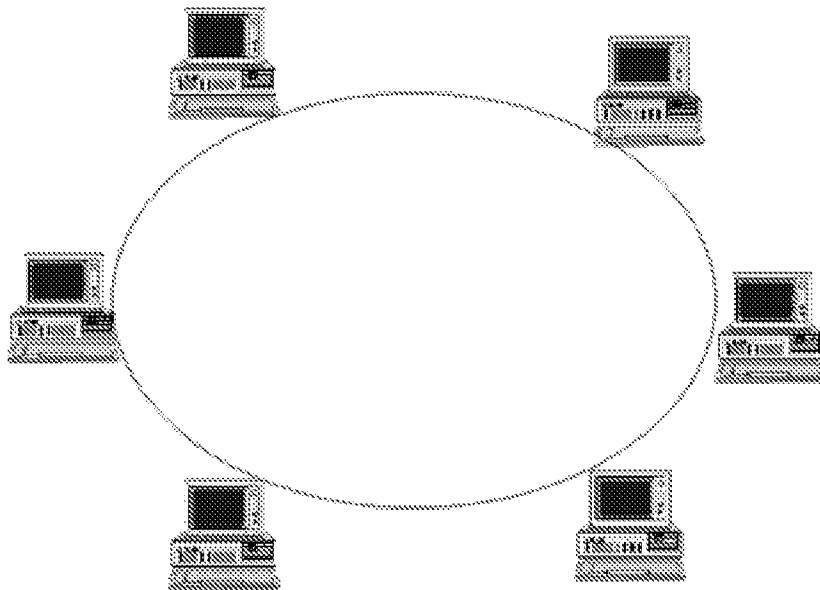


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The Client-Server Model



The Peer-to-Peer Model



Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-15, 20-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft White Paper, "Understanding Patch and Update Management: Microsoft's Software Update Strategy", Microsoft Corporation, pages: i-iii, 1-14, October 2003, and in further view of Microsoft dictionary (or a peer-to-peer network architecture definition).

Given the broadest reasonable interpretation of followed claims in light of the specification.

As per Claim 1: Microsoft discloses,

A method for automatically distributing a software update to a network of devices of a peer-to-peer network controlled by an organization, the method comprising:

receiving application and system information from one or more inoculation clients installed on the devices, the receiving performed via peer-to-peer communication; (See the whole reference, particularly, Microsoft provides tools to a client within a small Organizations (p.7),

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Medium-Sized Organizations (p. 9), Large Organizations (p. 11), etc., these organizations are inoculation client application and system information peer-to-peer receiver);

comparing the application and system information with application and version information in a global update repository to determine if an update exists for a corresponding application controlled by an inoculation client, the global update repository including updates from multiple application manufacturers;

(For example, see, p. 7, p. 10, Microsoft Baseline Security Analyzer supports security update that has means for comparing application and system information with the application and version information in an update repository. The analyzer supports for performing the security updates portion of a scan. Also see p 11, Microsoft Download website ('update repository'). See p. 13, "Microsoft Update", scheduled for release in Spring 2004, will consolidate the patches and updates into one repository ('update repository'). At launch, Microsoft Update will support patches, updates, and service packs for Windows 2000, XP, Server 2000 & 2003 operating systems as well as Microsoft Office 2003, Microsoft SQL Server 2000, and Microsoft Exchange Server 2003);

queueing the update if an update exists for an application controlled by an inoculation client; receiving a communication from the corresponding inoculation client checking for available distribution jobs;

(For example, the baseline security Analyzer allows users to scan (*queue*) one or more Windows-based computers for common security misconfigurations (p. 7-8) (i.e. has means for *checking for available distribution jobs* – also has means for *comparing said application and system*

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information), Security Update Inventory Tool provides ongoing scans of client computers for installed or applicable security updates (p. 11), Microsoft Baseline Security Analyzer 2.0 provides a true enterprise-ready scanning technology (p. 13). See content within Microsoft Baseline Security Analyzer 2.0 (p.13)); *and*

automatically transmitting the update to the corresponding inoculation client in response to the receiving a communication if an update exists for an application controlled by the corresponding inoculation client (For example, see Distribute Software Updates Wizard Installer (p. 11-12) and see Office Update Inventory Tool).

Microsoft does not explicitly mention to receive information from “peer-to-peer” network.

However, its dictionary defines the data distribution via peer-to-peer: See peer-to-peer architecture, p. 397. It appears that two computers which are communicable in a network can share data, thus meet the means of peer-to-peer network. The adding of peer-to-peer network is only changing in shape of a component. It does not cause any new or unexpected result in term of receiving a patch.

Therefore, it is obvious to an ordinary in the art to use either client/server architecture or peer-to-peer architecture because it does not cause any new result.

Microsoft does not explicitly mention GLOBAL UPDATE REPOSITORY, but its website Microsoft Download website (‘update repository’) and in p. 13, “Microsoft Update”, it mentions a future consolidation of a centralized update database.

Thus, it is obvious to the ordinarily in the art that, GLOBAL UPDATE REPOSITORY is only a centralized storage for easing management. It is only making integral thus renders obviousness.

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As per Claim 2: Microsoft discloses, *The method of claim 1, further comprising: configuring an inoculation server distributed across one or more of the devices; and performing an initial connection between the inoculation server and the global update repository* (For example, see P. 6: the AutoUpdate feature can be configured to retrieve patches directly from Windows Update at regular intervals. Individuals can choose whether to be prompted to install new updates or have them install automatically. See p. 9-10: Clients are configured to connect to specific servers and can be configured for automatic software update installations or end-user prompting).

As per Claim 3: Microsoft discloses, *The method of claim 1, wherein the application and system information includes operating system information and version* (See content within Microsoft Update (p. 13)).

As per Claim 4: Microsoft discloses, *The method of claim 1, wherein the application and system information includes installed software applications and versions* (See Software Updates Installation Agent (p.12)).

As per Claim 5: Microsoft discloses, *The method of claim 1, wherein the application and system information includes network information* (For example, see Virus Information Alliance, p. 5).

As per Claim 6: Microsoft discloses, *The method of claim 1, wherein the application and system information is received in Extensible Markup Language (XML) format* (See Office Update Inventory Tool (p. 11)).

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As per Claim 7: Microsoft discloses, *The method of claim 1, wherein the queuing the update includes linking the update package and the corresponding application in a database table* (For example, see Software Update Services Feature Pack, p. 11).

As per Claim 8: Microsoft discloses, *The method of claim 1, wherein the global update repository is a centralized repository that manages operating systems and software to be delivered to inoculation servers.* (i.e. Microsoft downloads Web site; or see “consolidate the patches and updates into one repository” (p. 13)).

As per Claim 9: Microsoft discloses, *The method of claim 8, therein the global update repository mines, retrieves, and archives external update information* (i.e. Microsoft/Microsoft downloads Web site; or see “consolidate the patches and updates into one repository” (p. 13)).

As per Claim 10: Microsoft discloses, *The method of claim 9, wherein the external update information is mined and retrieved from external security websites* (i.e. Microsoft/Microsoft downloads Web site; or see “consolidate the patches and updates into one repository” (p. 13)).

As per Claim 11: Microsoft discloses, *The method of claim 10, wherein the global update repository uses web spiders* (i.e. Microsoft/Microsoft downloads Web site; or see “consolidate the patches and updates into one repository” (p. 13)).

As per Claim 12: Microsoft discloses, *The method of claim 1, wherein the comparing includes utilizing an HTTP GET or POST command.* (The commands are standard used by HTTP protocol. Functional equivalence: “command line operations for scanning one or more Windows-based computers” (p. 8); “MBSA UI or in the MBSA command line interface, seen in p. 7”)

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As per Claim 13: Microsoft discloses, The method of claim 9, wherein the external update information contains a vendor type, the vendor type being automatic download and release, automatic download and manually confirm release, or manually download and confirm (See section Software Update Service 2.0, p. 13).

As per Claim 14: Microsoft discloses, *The method of claim 1, wherein the comparing is performed by an inventory control engine* (e.g. Security Update Inventory Tool, p. 11).

As per Claim 15: Microsoft discloses, *The method of claim 1, wherein the queuing is performed by a distribution engine* (e.g. Distribute Software Updates Wizard, p. 12).

As per Claim 20: Microsoft discloses claim 20. See rationale in addressed in Claim 1.

As per Claim 21: Microsoft discloses, *The apparatus of claim 20, further comprising: means for configuring an inoculation server distributed across one or more of the devices; and means for performing an initial connection between the inoculation server and the global update repository.*

See rationale in addressed in Claim 2.

As per Claim 22: Microsoft discloses, *The apparatus of claim 20, wherein the application and system information includes operating system information and version.* See rationale in addressed in Claim 3.

As per Claim 23: Microsoft discloses, *The apparatus of claim 20, wherein the application and system information includes installed software applications and versions.* See rationale in addressed in Claim 4.

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As per Claim 24: Microsoft discloses, *The apparatus of claim 20, wherein the application and system information includes network information.* See rationale in addressed in Claim 5.

As per Claim 25: Microsoft discloses, *The apparatus of claim 20, wherein the application and system information is received in Extensible Markup Language (XML) format.*

See rationale in addressed in Claim 6.

As per Claim 26: Microsoft discloses, *The apparatus of claim 20, wherein the queuing the update includes linking the update package and the corresponding application in a database table.* See rationale in addressed in Claim 7.

As per Claim 27: Microsoft discloses, *The apparatus of claim 20, wherein the global update repository is a centralized repository that manages operating systems and software to be delivered to inoculation servers.* See rationale in addressed in Claim 8.

As per Claim 28: Microsoft discloses, *The apparatus of claim 20, therein the global update repository mines, retrieves, and archives external update information.* See rationale in addressed in Claim 9.

As per Claim 29: Microsoft discloses, *The apparatus of claim 28, wherein the external update information is mined and retrieved from external security websites.*

See rationale in addressed in Claim 10.

As per Claim 30: Microsoft discloses, *The apparatus of claim 29, wherein the global update repository uses web spiders.* See rationale in addressed in Claim 11.

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As per Claim 31: Microsoft discloses, *The apparatus of claim 20, wherein the means for comparing includes means for utilizing an HTTP GET or POST command.* See rationale in addressed in Claim 12.

As per Claim 32: Microsoft discloses, *The apparatus of claim 28, wherein the external update information contains a vendor type, the vendor type being automatic download and release, automatic download and manually confirm release, or manually download and confirm.* See rationale in addressed in Claim 13.

As per Claim 33: Microsoft discloses, *The apparatus of claim 20, wherein the means for comparing is an inventory control engine.* See rationale in addressed in Claim 14.

As per Claim 34: Microsoft discloses, *The apparatus of claim 20, wherein the means for queuing is a distribution engine.* See rationale in addressed in Claim 15.

As per Claim 35: Microsoft discloses claim 35. See rationale in addressed in Claim 1.

As per Claim 36: Microsoft discloses claim 36. See rationale in addressed in Claim 1.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ted T. Vo whose telephone number is (571) 272-3706. The examiner can normally be reached on 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Y. Zhen can be reached on (571) 272-3708.

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The facsimile number for the organization where this application or proceeding is assigned is the Central Facsimile number **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTV
September 19, 2008

/Ted T. Vo/
Primary Examiner, Art Unit 2191